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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,025	11/03/2003	Stephen Bennett Elliott	1119-003	2143
27820 7590 04/03/2009 WITHROW & TERRANOVA, P.L.L.C. 100 REGENCY FOREST DRIVE SUITE 160 CARY, NC 27518				
EXAMINER				
BOCKELMAN, MARK				
ART UNIT		PAPER NUMBER		
3766				
MAIL DATE		DELIVERY MODE		
04/03/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/699,025

**Applicant(s)**

ELLIOTT, STEPHEN BENNETT

**Examiner**

Mark W. Bockelman

**Art Unit**

3766

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 5, 7, 9, 11-15, 17-20, 22, 24 and 26-45 is/are pending in the application.
- 4a) Of the above claim(s) 26-45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 5, 7, 9, 11-15, 17-20, 22, 24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

Claims 1, 3, 5, 7, 9, 11-15, 17-20, 22 and 24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant recites that the feedback signal provides instruction to the patient. The original specification only has the feedback signal providing and indication to the patient and instruction further provided for the patient by a person instructing the patient. The device is merely a signal indicator and provides no instruction. Applicant's claims as now written involve new matter.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,3, 5, 7, 9, 11-15, 17-20, 22, 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Vachillo USPN 5,997,482. Vachillo provides a feedback monitor that display current heart rates and would thus show graphically all changes in heart

rate including maximum heart rates, minimum heart rates and transitions from maximums to minimums and also provides phase angles between breathing rate and heart rate at all such heart rates. The disclosure also suggests that breathing conditioning is used wherein a patient attempts to minimize phase differences between the breathing cycle and the heart rate cycle to match the peaks and troughs and thus the signal is one telling the patient when to inhale and exhale. The peaks on the rate monitor as well as the phase angle are thus considered to be the signal to indicate breathing changes. The feedback device also provides a feedback phase difference angle which is considered to be an offset value. All values are capable of being programmable and thus the term "programmable" alone offers no patentable distinction.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,3, 5, 7, 9, 11-15, 17-20, 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stabler et al USPN 6,836,681. Stabler provides the patient with a heart rate variability monitor that shows peaks and troughs as well as heart rates that are offset from the maximum and minimums. Such values are capable of being programmed into a computer making them programmable values. Applicant's claims merely provide for a patient to watch the monitor, the claims do not specify a specific

instruction or action of the patient to inhale or exhale only that the monitor trace indicates such is the time to be done. To have had the patient watch his own heart rate variability being monitored would have been obvious in view of Stabler so as to provide feedback to the patient to better control such.

### ***Response to Arguments***

Applicant's arguments filed 12-16-2008 have been fully considered but they are not persuasive. Not one passage cited by applicant describes the feedback indicator as providing an instruction. This is because beeps, blips and other indicators provide indication much like a traffic light. The reason people stop at a red light and go on a green light is because they learned this in driving school where they were instructed to do so. The same holds true for an indicator light on the dashboard of a car. It usually requires one to refer to their owner's manual to diagnose the condition. Applicant is trying to massage his specification into something that it isn't. Applicant appears to be more interested in covering the apparatus than the method. The art cited displays to the patient their heart rate and how it varies. While applicant doesn't show an embodiment where the indicator is a heart rate display, it does not exclude such either. If the applicant had an embodiment where patients were told to inhale at the maximum value shown on the display applicant would consider this to be an instruction to do so and the maximum would be the exact moment to do so or just after the maximum depending on the instructions given to the patient as to when to inhale/exhale during indication. The examiner is applying the art in a similar fashion as applicant is interpreting his

specification. Applicant seems want to have it both ways. He does not want to claim any steps outside the operation of the machine and instead refers to an indicator element as an instruction in attempt to define over another machine that performs the same function as the claim is written yet objects when the examiner provides a similar interpretation to the art. Apparently an indicator is only an instruction when applicant says it is an instruction. The applicant is quite aware of what amendments he could make to overcome the art and 112 rejection but refuses to do so. Instead he argues that the words of the claim require special meaning

In is clear that applicant through simple amendments can overcome the rejections applied but is not interested in doing so.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark W. Bockelman whose telephone number is (571) 272-4941. The examiner can normally be reached on Monday - Friday 8:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Layno can be reached on (571) 272 -4949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark W Bockelman/  
Primary Examiner, Art Unit 3766  
March 30, 2009